

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/688,134

REMARKS

Claims 1-18 are all the claims pending in the application.

In response to the Amendment filed April 12, 2004, the Examiner has repeated the previous claim rejection. Thus, the status of the claims is the following.

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over previously-cited Shimizu (US 5,987,230) in view of previously-cited Yokomizo et al. (US 6,321,266).

Applicant submits the following arguments in traversal of the prior art rejections.

In the Amendment of April 12, 2004, Applicant argued that Shimizu fails to disclose the device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information, as recited in claim 1. In response to this argument, the Examiner now points to col. 1, lines 62-63 of Shimizu, which discloses two-sided printing control. The Examiner asserts that the two-sided printing control corresponds to a printer that is connectable to or incorporated into the data terminal and is capable of printing on opposite sides of a recording sheet. However, these alleged disclosures of the reference do not correspond to the above-recited features of claim 1. As described above, claim 1 recites a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information. Applicant submits that Shimizu is silent regarding such a device. The ability of a printer to print on two sides of a medium does not necessarily imply a selection of which of the two sides is to be printed. The Examiner may not properly speculate that this selection is occurring in maintaining the rejection. Shimizu does not even suggest a

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/688,134

manner by which a user can choose a side of a recording sheet to print ad data with respect to the information obtained from a network. Hence, claim 1 is allowable.

Applicant also argued that Shimizu does not teach or suggest the feature of claim 1 of a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data. The Examiner's response to this argument refers to col. 1, lines 60-65; col. 2, lines 8-9; and col. 4, line 44. However, none of the cited excerpts of the reference teach or suggest the above-described features of claim 1. Specifically, claim 1 recites that the print control device produces the print image data in accordance with which side of the recording sheet the ad data is to print. Shimizu fails to disclose a print control device having such a feature. Thus, claim 1 is allowable for this reason also.

With further regard to claim 1, Applicant argued in the April 12 Amendment that the prior art fails to teach or suggest a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information. Here, the Examiner responded by referring to the disclosure in Yokomizo of an Ethernet controller 113, in col. 16, lines 41-44. However, the cited excerpt only discloses the following: "The Ethernet controller 113 performs a control of electric timings and a control of data transmission and receipt. TCP/IP communication program 82 is controlled by the CPU 101 by utilizing the Ethernet controller 113." Clearly, this excerpt does not disclose the claimed charge modification data sending device, which modifies the charge for the information in accordance with amount of ad data printed with the information. Col. 16, lines 41-44 does not

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/688,134

even relate to the concept of charging for information. Hence, claim 1 is allowable for this additional reason. Claims 13-16 specify that the charge modification relates to a cost to be paid by a user. The interface features cited by the Examiner do not pertain to any such costs.

Therefore, for at least the above-noted reasons, as well as the reasons discussed in the Amendment filed April 12, 2004, claim 1 and its dependent claims 2, 3, 5, 6, 13 and 17 are allowable over the prior art.

Regarding claim 4, the Examiner responds to the Applicant's argument that Shimizu does not disclose a sorting device for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information, by pointing to a portion of the reference which relates to the relationship between memory sizes, i.e., col. 9, lines 62-67. Applicant submits that the relationship of memory sizes disclosed in Shimizu is unrelated to the above-mentioned feature of claim 4. The sorting device of claim 4 detects a category of information to print and automatically sorts ad data relating to the detected category of information. The size of a memory is not included in the claimed sorting device. Moreover, Shimizu does not disclose a sorting device having the features of claim 4. Accordingly, claim 4 is allowable over the prior art.

Additionally, claim 4 is allowable over the prior art for reasons analogous to those discussed above in relation to claim 1.

Therefore, claim 4 and its dependent claims 6, 14 and 18 are allowable over the prior art, for the above-described reasons and the reasons presented in the Amendment filed April 12, 2004.

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/688,134

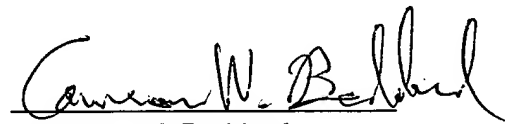
Applicant submits that claims 7-9 and 15 are allowable over the prior art for reasons analogous to those presented above in relation to claim 4.

Additionally, claims 10-12 and 16 are allowable over the prior art for reasons analogous to those presented above for claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Cameron W. Beddard
Registration No. 46,545

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 20, 2004